

REMARKS

The Office Action mailed on July 1, 2002 has been received and reviewed. Claims 1 through 10 are currently pending in the application. Applicants have amended claims 1, 6, and 7 and submitted new claims 11 through 17.

Claim 1 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Veenema (US 3,989,157, hereinafter "Veenema") in view of Auer (US 4,557,091, hereinafter "Auer").

Claims 2-5 have rejected under 35 U.S.C. 103(a) as being unpatentable over Veenema and Auer as applied to claim 1, in further view of De Zen (US 6,189,269B1, hereinafter "De Zen").

Claims 6-10 have rejected under 35 U.S.C. 103(a) as being unpatentable over Veenema and Auer, and further in view of De Zen.

Based on the arguments presented herein below and the amendments submitted herein, Applicants respectfully submit that the above-summarized rejections have been overcome. Reconsideration of the above-referenced application is respectfully requested.

Claim Interpretation

Presently amended independent claims 1 and 6 are Jepson-type claims as required by 37 C.F.R. 1.75(e). Therefore, Applicant respectfully resubmits that the preamble of such claims in the above-referenced application, directed to a passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft, constitutes a proper claim limitation which can be relied upon to distinguish the claim over the cited art. To begin with, the Office is kindly reminded that the form of the claim itself, the so-called "Jepson" form, suggests the structural importance of the recitations found in the preamble. The Jepson form allows a patentee to use the preamble to recite "elements or steps of the claimed invention which are conventional or known" 37 C.F.R. 1.75(e). When this form is employed, the claim preamble defines not only the context of the claimed invention, but also its scope. See *Pentec, Inc. v. Graphic Controls, Corp.*, 776 F.2d 309, 315, 227 U.S.P.Q. (BNA) 766, 770 (Fed. Cir. 1985) ("Although a preamble is impliedly admitted to be prior art when a Jepson claim is used, . . . the

claimed invention consists of the preamble in combination with the improvement.") (citations omitted); United States Patent and Trademark Office, Manual of Patent Examining Procedure § 608.01(m) (6th ed. rev. Sept. 1995) ("[The Jepson form of claim] is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination."). Thus, the form of the claims in the above-referenced application themselves indicates Applicant's intention to use the preamble to define, in part, the structural elements of the claimed invention. Therefore, the device for which the patent claims "an improvement" is a "passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft."

35 U.S.C. § 103(a) Obviousness Rejections

(A) Applicable Authority

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.03, *i.e.*, in order "to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success in combining the references. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the expectation of success must both be found in the prior art, and not based on Applicants' disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, in establishing a *prima facie* case of obviousness the initial burden is placed on the examiner. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See also MPEP § 706.02(j) and § 2142.

The Supreme Court has established the standard of patentability to be applied in obviousness rejections in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). This standard has been summarized in MPEP § 2141 into four factual inquiries including “(A) determining of the scope and contents of the prior art; (B) ascertaining the differences between the prior art and the claims in issue; (C) resolving the level of ordinary skill in the pertinent art; and (D) evaluating evidence of secondary considerations.” It should be noted that, when applying the required patentability standards of *Graham*, the basic considerations which apply to obviousness rejections based on 35 U.S.C. § 103 should include the following principles of patent law: “(A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined.” *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

(B) Obviousness rejections of claim 1 over Veenema in view of Auer.

Applicant respectfully traverses the rejection and submits that Veenema and Auer, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the present invention recited in the presently amended claim 1 because (i) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art of the instant invention to modify the reference or to combine the reference teachings; and (ii) the prior art references do not teach or suggest all the limitations recited therein (*Vaeck*, supra).

Applicant respectfully submits that the lack of suggestion and motivation to combine Veenema and Auer is based on the fact that the proposed modification of the combination of Veenema and Auer to find obviousness in the present invention at most renders the prior art of Veenema unsatisfactory for its intended purpose or, at least, changes its principle of operation. It is well known that “if proposed modification would render the prior art invention being modified

unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Veenema reference is directed to a container assembly. Veenema does not appear to contain any teaching or suggestion that the container assembly defines a passageway between an aircraft terminal building and a docked aircraft. The dictionary defines a passageway as “a way that allows passage” (Webster Dictionary, 2002). In fact such a passage or pathway appears precluded in the Veenema construction by the end panels (15). See Fig. 4 and Col. 3, lines 43-64. Special attention is directed to Col. 3, lines 57-59 wherein Veenema indicates that the container assembly is constructed to be completely sealed. Applicant submits that a container that is completely sealed precludes the claimed function of a passageway, i.e., a way that allows passage. Applicant respectfully maintains that the Veenema is directed to a container structure that is constructed to receive and retain an article. The Veenema container is not intended to function as a passageway nor does it define a pathway for travel between an aircraft terminal building and a docked aircraft. Therefore, contrary to the Office’s conclusion based on *Ex parte Masham* (Office Action, page 2, item 2), Veenema’s apparatus and the present invention have significantly different structural limitations.

Auer relates generally to structural systems, and specifically relates to extruded structural systems which include extruded structural panels and extruded panel joining members for assembling a structural system with a plurality of panels (Auer, col. 1, lines 9-13). Auer teaches explicitly that “structural assemblies made with the preferred embodiment of the present invention may be successfully employed in such diverse applications as electrical utility cooling tower louvers, floating covers for oil and other petroleum product storage tanks, anti-corrosive structures for use in harsh chemical plant environments, computer room flooring, self-supporting conduit for electrical and utility cabling, energy efficient insulated building siding for storage

shelters and refrigerated enclosures, air intake housings and ducting, architectural room dividers, and heavy equipment hoods and enclosures” (Id., col. 1, line 65 – col. 2, line 8). Applicant respectfully submits that Auer does not teach or suggest the use of his invention in a passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft. Furthermore, there is no suggestion in Auer to modify Veenema’s container to create a passageway. Therefore, citation of Veenema as a passageway changes the principle of operation of Veenema’s container invention, thus rendering it unsatisfactory for its intended purpose. The combination of Auer and Veenema does not remedy the inappropriateness of the use of the Veenema reference as prior art for the above-referenced invention. Therefore, the combination of Veenema and Auer cannot support a finding of obviousness of the instant invention for a lack of motivation or suggestion to combine the references.

Further, Applicant respectfully submits that Veenema and Auer, individually or in any combination thereof, cannot support a finding of obviousness of the instant invention because they do not teach all of the limitations recited in the presently amended claim 1. As previously stated, presently amended claims 1 is a Jepson-type claim as required in 37 C.F.R. 1.75(e). Consequently, its preamble, directed to a passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft, constitutes a proper claim limitation that can be relied upon to distinguish the claim over the cited art. Veenema and Auer, individually or in any combination thereof, do not teach the limitation of a passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft; therefore, they do not support a finding of obviousness of presently amended claim 1. Finally, assuming *arguendo* that the combination of Veenema and Auer may teach elements of the above-referenced invention, a rejection based on a *prima facie* case of obvious is improper unless the motivation to combine the cited prior art references is objectively articulated. “A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that [some] aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to

combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). See also *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The Office is kindly reminded that "in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). A finding to the contrary, neglecting the requirements of *Ellis*, *Oetiker*, and *Deminski*, *supra*, can only be justified by use of the benefit of impermissible hindsight vision afforded by the Applicant's claimed invention—a procedure contrary to current principles of patent law (cf. *Hodosh*, *supra*).

(C) Obviousness rejection of claims 2 through 5 over Veenema and Auer as applied to claim 1, in further view of De Zen.

Claims 2 through 5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Veenema and Auer as applied to claim 1, in further view of De Zen. Applicant respectfully traverses the rejection.

Each of claims 2 through 5 is dependent from independent claim 1. The Examiner relies on the combination of Veenema and Auer as teaching all of the claim limitations of independent claim 1, and then cites De Zen as teaching the additional subject matter of claims 2 through 5.

As set forth above with respect to claim 1, Veenema and Auer fail to provide the suggestion or motivation for their combination and to teach or suggest all the claim limitations of claim 1, which limitations are incorporated by way of dependency in claims 2 through 5. Specifically, the citation of Veenema to teach or suggest the invention recited in presently amended claim 1 renders it inoperable as a sealed container as already explained. Further, the

addition of Auer does not remedy that problem. Further, Veenema and Auer do not teach or suggest all of the claim limitations recited in claim 1. Applicant respectfully submits that De Zen, relating to wall members securing wiring in channels interiorly of a hollow structure formed by the wall forming member and other wall forming members adapted to accept concrete or other material therein to enable a structure erected there from to be anchored to a base and converted into a permanent and essentially indestructible structure, does not remedy the lack of motivation or suggestion to combine Veenema and Auer nor does it, in combination with Veenema and Auer, teach all of the limitations of the invention recited in claim 1 as required by law in order to support a finding of obviousness of presently amended claim 1. Therefore a finding of obviousness of claim 1 based on Veenema, Auer, and De Zen is not proper. Thus independent claims 1 is not made obvious by the additional prior art reference of De Zen and because "independent claim [1 is] nonobvious under 35 U.S.C. 103, claim[s 2 through 5] depending there from[, are also] nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully request reconsideration and allowance of claims 2 through 5.

(D) Obviousness rejection of claims 6-10 over Veenema and Auer, and further in view of De Zen.

Claims 6-10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Veenema and Auer, and further in view of De Zen. Applicant respectfully traverses the rejection. As already stated, presently amended independent claim 6 is a Jepson-type claim as required by 37 C.F.R. 1.75(e). Therefore, Applicant respectfully resubmits that the preamble of such claims in the above-referenced application, directed to a passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft, constitutes a proper claim limitation which can be relied upon to distinguish the claim over the cited art.

Applicant respectfully submits that Veenema, Auer, and De Zen, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the present invention recited in the presently amended claim 6 because (i) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art of the instant invention to modify the reference or to combine the reference teachings; and (ii) the prior art references do not teach or suggest all the limitations recited therein (*Vaeck*, supra).

Applicant respectfully submits that, similarly to the arguments presented hereinabove related to claim 1, the lack of suggestion and motivation to combine Veenema, Auer, and De Zen is based on the fact that the proposed modification of the combination of the three prior art references to find obviousness in the present invention changes the principle of operation in Veenema, rendering it unsatisfactory for its intended purpose (*Gordon and Ratti*, supra). Further, contrary to the Office's conclusion based on *Masham* (Office Action, page 5, item 4), Veenema's apparatus and the present invention recited in the presently amended claim 6 have significantly different structural limitations.

Applicant respectfully submits that neither Auer nor De Zen teach or suggest the use of their invention, individually or in any combination thereof, in a passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft. Furthermore, there is no suggestion in Auer and/or De Zen to modify Veenema's container to create a passageway. Therefore, citation of Veenema as a passageway changes the principle of operation of Veenema's container invention, thus rendering it unsatisfactory for its intended purpose. The combination of Auer, De Zen, and Veenema does not remedy the inappropriateness of the use of the Veenema reference as prior art for the instant invention recited in claim 6. Therefore, the combination of Veenema, Auer, and De Zen cannot support a finding of obviousness of the instant invention for a lack of motivation or suggestion to combine the references.

Further, Applicant respectfully submits that Veenema, Auer, and De Zen, individually or in any combination thereof, cannot support a finding of obviousness of the instant invention of presently amended claim 6 because they do not teach all of the limitations recited therein. As previously stated, presently amended claims 6 is a Jepson-type claim as required in 37 C.F.R. 1.75(e). Consequently, its preamble, directed to a passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft, constitutes a proper claim limitation that can be relied upon to distinguish the claim over the cited art. Veenema, Auer, and

De Zen, individually or in any combination thereof, do not teach the limitation of a passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft; therefore, they do not support a finding of obviousness of presently amended claim 6 (cf. *Levengood, Kotzab, Rouffet, Oetiker, Deminski, and Clay*, supra) unless impermissible hindsight afforded by the Applicant's claimed invention is improperly used (cf. *Hodosh*, supra).

Finally, each of claims 7 through 10 is dependent from independent claim 6. As just explained with respect to claim 6, Veenema, Auer, and De Zen fail to provide the suggestion or motivation for their combination and to teach or suggest all the claim limitations of claim 6 in support of a finding of obviousness. The limitations of presently amended claim 6 are incorporated by way of dependency in claims 7 through 10. Thus, because "independent claim [6 is] nonobvious under 35 U.S.C. 103, claim[s 7-10] depending there from[, are also] nonobvious" *Fine*, supra. Applicants respectfully request reconsideration and allowance of claims 6 through 10.

Newly Submitted Claims

Applicant respectfully submits that the subject matter recited in the newly submitted claims 11 through 17 is not new matter and is supported by the above-referenced application. Furthermore, Applicant states unequivocally that these new claims are not being submitted in response to the rejections of presently pending claims 1 through 10.

Applicant respectfully submits that the references cited in the Office Action of July 1, 2002, i.e., Veenema, Auer, and De Zen, do not support a finding of obviousness of the invention recited in the newly submitted claims 11 through 17 for reasons similar to the ones advanced herein as related to the presently amended claims 1 through 10. More specifically, there is no motivation or suggestion to combine Veenema, Auer, and De Zen, individually or in any combination thereof, to find obviousness of the invention recited in the newly submitted claim 11, i.e., a passageway for placement between an aircraft terminal and an aircraft for interconnecting said aircraft terminal with said aircraft, said passageway comprised of a plurality of passageway modules, wherein the improvement in each of said passageway module consists

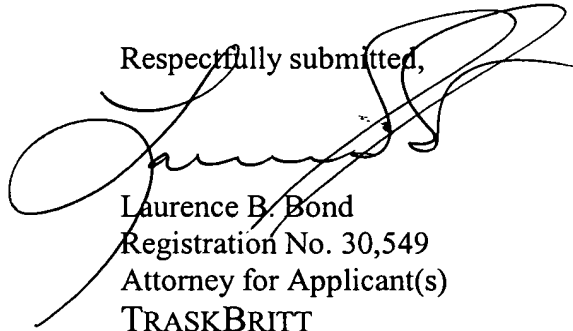
essentially of: a floor element; two wall elements positioned atop said floor element, said wall elements being positioned spacedly apart from one another and extending uprightly from said floor element; a ceiling element positioned atop said two wall elements (wherein said floor element, said wall elements and said ceiling element are fabricated from at least one pultruded panel defining a honeycomb cross section); and connection structure for interconnecting said modules, one to another at their respective ends to form a continuous passageway (wherein said connection structure further comprises a pair of frame structures, said frame structures having an upwardly extending ear and a downwardly extending ear; a first pair of angle defining elongate connection elements for inter-cooperating with said upwardly extending ear and two ceiling elements of said modules; a second pair of angle defining elongate connection elements for inter-cooperating with said downwardly extending ear and two floor elements of said modules; and engaging structure for interconnecting said first pair of angle defining elongate connection elements with said pair of frame structures and for interconnecting said second pair of angle defining elongate connection elements with said pair of frame structures).

Even assuming in *arguendo* that such a combination of these three prior art references would be acceptable, the combination would not teach all of the limitations recited in the newly submitted claim 11. Claim 12 through 17, being dependent on claim 11, are also nonobvious over Veenema, Auer, and De Zen, at least because of their dependency to claim 11 (*Fine, supra*).

CONCLUSION

In view of the present amendments and the arguments advanced, Applicant respectfully requests reconsideration of its application.

Respectfully submitted,



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Enclosure: Version of Claims with Markings to Show Changes Made

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VERSION OF AMENDED CLAIMS
WITH MARKINGS TO SHOW CHANGES MADE

1. (Twice Amended) In a boarding bridge, a passageway which defines a pathway for travel between an aircraft terminal and a docked aircraft, wherein the improvement in said passageway [comprising] comprises:

a floor element;

two wall elements positioned atop said floor element, said wall elements being positioned spacedly apart from one another and extending uprightly from said floor element;

a ceiling element positioned atop said two wall elements;

wherein said floor element, said wall elements and said ceiling element are fabricated from at least one pultruded panel.

6. (Amended) A passageway for placement between an aircraft terminal and an aircraft for interconnecting said aircraft terminal with said aircraft, wherein the improvement in said passageway [comprising] comprises:

a plurality of passageway modules, each module comprising:

a floor element;

two wall elements positioned atop said floor element, said wall elements being positioned spacedly apart from one another and extending uprightly from said floor element;

a ceiling element positioned atop said two wall elements;

wherein said floor element, said wall elements and said ceiling element are fabricated from at least one pultruded panel defining a honeycomb cross section; and

connection structure for interconnecting said modules, one to another at their respective ends to form a continuous passageway.

7. (Twice Amended) The passageway of claim 6 wherein said connection structure comprises:

a pair of frame structures, said frame structures having an upwardly extending ear and a downwardly extending ear;

a first pair of angle defining[,] elongate connection elements for [interco-operating] inter-cooperating with said upwardly extending ear and two ceiling elements of said modules;

a second pair of angle defining[,] elongate connection elements for [interco-operating] inter-cooperating with said downwardly extending ear and two floor elements of said modules;

and

engaging structure for interconnecting said first pair of angle defining elongate connection elements with said pair of frame structures and for interconnecting said second pair of angle defining elongate connection elements with said pair of frame structures.